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JJGjr: 02-03

Paper 7

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FEB 27 2003
OFFICE OF PETITIONS

In re Application of

Valenzuela, et al.

Application No. 09/577,209

Filed: 23 May, 2000

Attorney Docket No. B0843-991160

DECISION ON PETITION

This is the decision on the petition filed on 22 October, 2002, to revive the above-identified application under 37 C.F.R. §1.137(a),¹ however in light of the petition submitted via FAX on 24 February, 2003, under 37 C.F.R. §1.137(b)² to revive the above-identified application as having been abandoned due to unintentional delay.

The petition under 37 C.F.R. §1.137(b) is **GRANTED**, and the petition under 37 C.F.R. §1.137(a) is **DISMISSED**.³

¹ A Petition filed under the provisions of 37 C.F.R. §1.137(a) must be accompanied by:

- (1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application for patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) the petition fee required by 37 C.F.R. §1.17(l);
- (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the reply due date until the filing of a grantable petition pursuant to the is paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c).

² Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.
- (2) the petition fee as set forth in 37 C.F.R. §1.17(m);
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and
- (4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

³ Pursuant to Petitioner's authorization, the petition fee for the petitions under 37 C.F.R. §1.137(a) (\$110.00) and §1.137(b) (\$1,300.00), and the late-filing surcharge (\$130.00) are charged to Deposit Account 07-1896.

BACKGROUND

The record indicates that:

- the application became abandoned for failure to reply timely and properly to the Notice of Missing Parts (Oath or Declaration with surcharge (\$130.00)) mailed on 31 July, 2000, and due (absent extension of time) on or before 30 September, 2000;
- Petitioner alleges that the response may have been filed into the wrong application;
- the application went abandoned after midnight 30 September, 2000;
- Notice of Abandonment was mailed on 18 September, 2002;
- the petition filed (with the required reply--i.e., oath/declaration and surcharge) on 22 October, 2002, under 37 C.F.R. §1.137(a) alleges unavoidable delay, however, Petitioner submitted no evidentiary support for the allegation as required;
- on 24 February, 2003, Petitioner filed via FAX a petition (with fee authorization) under 37 C.F.R. §1.137(b);
- at that time, Petitioner also made the statement of unintentional delay.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁴

The regulations at 37 C.F.R. §1.137 set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally abandoned application under this congressional grant of authority .

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted

⁴ 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

on petition.⁵

Delays in responding properly raise the question whether delays are unavoidable.⁶ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁷ Petitioner must be diligent in attending to the matter.⁸

Moreover, it long has been the position of the Office that the use of the filing periods (such as in 37 C.F.R. §1.137(b)) as an "extension of time" is an "abuse" of the procedures for reviving abandoned applications, and is contrary to the meaning and intent of the regulation.⁹

The Office has indicated that petitions to revive must be filed promptly after the applicant becomes aware of the abandonment.¹⁰ Failure to do so does not demonstrate the care required under Pratt, and so cannot satisfy the test for diligence and due care.

By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.¹¹

Allegations as to Unavoidable Delay

Petitioner's showing as to a basis for the allegation of unavoidable delay is insufficient. While there may have been a lapse or mistake by counsel, it in no way satisfies the Pratt showing required herein.

⁵ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁶ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

⁷ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁸ See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

⁹ See: *In re Application of S*, 8 USPQ2d 1630, 1632 (Comm'r Pats. 1988). Where there is a question whether the delay was unintentional, the petitioner must meet a burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 C.F.R. §1.137(b). See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

¹⁰ See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

¹¹ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

More than 35 years ago the Court of Customs and Patent Appeals warned practitioners in Lorenz v. Finkl¹² that "ordinary prudence" demands that they take "appropriate action" as directed by the Office, and practitioners disregard this warning at peril to their client's matters. (Moreover, as long as the attorney/agent has not acted to deceive the client,¹³ the act(s) or omissions of the attorney/agent are imputed wholly to the applicant/client who hired the attorney/agent.¹⁴)

Allegation of Unintentional Delay

Petitioner has filed a petition and fee under 37 C.F.R. §1.137(b), and stated therein that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional."

The record (including the petitions filed on 22 October, 2002, and on 24 February, 2003) does not necessitate a finding that the delays between midnight 20 September, 2000, and 24 February, 2003, were not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on Petitioner's (Counsel Barry Young (Reg. No. 27,744) duty of candor and good faith when accepting Petitioner's representation that the delay in filing the response was unintentional.¹⁵

CONCLUSION

Therefore, the petition to revive under 37 C.F.R. §1.137(b) hereby is **granted**, and the petition to revive under 37 C.F.R. §1.137(a) is **dismissed**.

This application is being forwarded to OIPE for further processing, before being forwarded for examination in due course.

¹² Lorenz v. Finkl, 142 USPQ 26, 27-28 (CCPA 1964).

¹³ When an attorney intentionally conceals a mistake he has made, thus depriving the client of a viable opportunity to cure the consequences of the attorney's error, the situation is not governed by the stated rule in Link for charging the attorney's mistake to his client. In re Lonardo, 17 USPQ2d 1455 (Comm'r. Pat. 1990).

¹⁴ The actions or inactions of the attorney/agent must be imputed to the petitioners, who hired the attorney/agent to represent them. Link v. Wabash Railroad Co., 370 U.S. 626, 633-634, 82 S.Ct. 1386, 1390-91 (1962). The failure of a party's attorney to take a required action or to notify the party of its rights does not create an extraordinary situation. Moreover, the neglect of a party's attorney is imputed to that party and the party is bound by the consequences. See Huston v. Ladner, 973 F.2d 1564, 23 USPQ2d 1910 (Fed Cir. 1992); Herman Rosenberg and Parker-Kalon Corp. v. Carr Fastener Co., 10 USPQ 106 (2d Cir. 1931).

¹⁵ See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).

Telephone inquiries regarding this decision may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to read 'J. Gillon, Jr.', with a stylized flourish at the end.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions